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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/888,452
Applicant: Gopalan
Filing Date: 06/25/2001
Group Art Unit: 2134
Title: Apparatus and Method for Providing a Centralized Personal Database Accessed by Combined Multiple Identification Numbers

SUPPLEMENTAL APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Supplemental Appeal Brief is support for the appeal in the above referenced application and is filed pursuant to the Notice of Appeal dated 4/29/2004, the Appeal Brief filed May 11, 2004, and to the Office Action mailed by the Examiner on 7/28/04. In the Office Action mailed by the Examiner on 7/28/2004, the Examiner reopened prosecution and submitted a single new reference, <http://java.sun.com/devlOper?TechTips/1998/#0217.html> Tech Tips: February 17, 1998 (TIPS). In response Applicant submitted a Request for Reinstatement of Appeal. In accordance with the Request to Reinstate the Appeal, applicant simultaneously filed

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Appeal Brief

SUPPLEMENTAL ISSUE

Does (TIPS) <http://java.sun.com/developer/TechTips/1998/#0217.html> (Tech Tips: February 17, 1998) render claims 1-26 unpatentable under 35 USC §103(a) by teaching or suggesting a database that can be accessed and modified by a consumer using a basic number and a primary number, and in which the database can be accessed, but not modified, by a merchant using the primary number and a secondary number?

INCORPORATION BY REFERENCE OF APPEAL BRIEF FILED MAY 11, 2004

In the Examiner's Office action mailed 7/28/04, the Examiner, in addition to reopening prosecution with TIPS, reasserted the grounds of rejection set forth in the 12/3/2003 office action by reference. Applicant addressed the 12/3/2003 office action in applicant's appeal brief filed May 11, 2004. Therefore, to the extent any response to the 12/3/2003 office action is required in this supplemental brief, applicant incorporates the appeal brief filed May 11, 2004 in its entirety into this supplemental appeal brief.

ARGUMENTS

I **The Examiner must meet all three prongs of the obviousness test in order to establish a *prima facie* case of obviousness.** The requirements for a *prima facie* case of obviousness are well defined:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on

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applicant's disclosure. MPEP §706.02(j) citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Similarly, the fact that the Examiner has the burden of proof with respect to the elements of the *prima facie* case of obviousness is also well defined:

To reject claims in an application under section 103, an examiner must show an unrebutted *prima facie* case of obviousness. In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

With respect to claims 1-26, the Examiner has not met his burden of presenting the *prima facie* case of obviousness with respect to the first or third prongs of the obviousness test because TIPS does not teach or suggest the limitations of claims 1-26, and there is no suggestion or motivation to modify the teachings of TIPS to obtain the limitations of claims 1-26.

2. The Examiner has not met his burden of presenting the *prima facie* case with respect to the third prong of the obviousness test because TIPS does not teach or suggest a database that can be accessed and modified by a consumer using a basic number and a primary number, and in which the database can be accessed, but not modified, by a merchant using the primary number and a secondary number.

Claim 1 reads:

1. A programmable apparatus comprising:

...
wherein a consumer uses a basic number and a primary number to access an account in the data base and the consumer can modify an account data in the data base; and

wherinc a merchant uses the primary number and a secondary number to access the account and the merchant is prohibited from modifying the account data in the data base.

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If use of multiple numbers (as argued in the Appeal Brief at pages 5-13 as being the crucial feature of novelty) is indeed not entirely clear, then Tech Tips should teach such multiple numbers. This Tech Tips is famous for teaching the "transient" keyword. The transient keyword permits e-commerce by controlling persistence during serialization. Thus, only certain numbers are accessible in accordance with each person engaged in e-commerce. Therefore, such multiple numbers were well known in the art for the motivation of permitting e-commerce.

The examiner's rejection based upon TIPS is incorrect. The examiner does not explain how TIPS is relevant to the applicant's claimed invention. The examiner presents only a conclusory statement that the "transient keyword permits e-commerce by controlling persistence during ...". ~~the transient keyword provides no motivation for how the invention functions~~

The TIPS reference is not relevant to applicant's claimed invention because transient keywords, transient values, and serialization, are tools available in JAVA programming for sending complex data structures to a file across a network. Applicant's invention, on the other hand, involves the use of a three number system. In the three number system, each of two parties receives two of the three numbers, but each have only one out of the three numbers in common. The three number system is used to control access to an account, and does not claim a method for converting objects into a stream of bytes for writing to a file across a network, as discussed by TIPS. For example, in regard to transient values and serialization, TIPS states:

The Java Programming language incorporates a feature known as serialization, which is used to convert objects (including complex data structures such as lists and trees) into a stream of bytes, for writing to a file or across a network. The stream can later be deserialized and converted back into an object. This feature is very useful for giving objects persistence, and for transmitting them to a remote location (page 2).

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TIPS further discusses specific aspects of the process of converting objects into a stream of bytes:

This example illustrates an interesting aspect of serialization. A field of a class may be declared as a transient, meaning that the field is not serialized. In other words, it's not part of the persistent state of an object. An example of where this situation matters is java.util.Hashtable. When a Hashtable object is serialized, the keys and values are written out as pairs of values, rather than written out as the actual table. This is because the underlying hash codes (see Object.hashCode) may differ when the table is reconstructed. In the above example, ivalue has the default value 0 when the saved object is deserialized (page 3).

However, none of the discussion in TIPS addresses the use of a three number code system where two parties each have two of the three numbers but each has only one common number.

The examiner's stated that "such multiple numbers were well known in the art for the motivation of permitting e-commerce." However, the examiner's statement neither addresses the claimed invention of applicant, nor explains how TIPS discloses the use of multiple numbers in the way the applicant has claimed. Applicant's limitations are captured in the following claim

~~limitation~~ "a number of numbers having a common number and a common number to another number

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to modify the reference to obtain the claimed invention. “Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). With respect to the claims 1-26, the Examiner has not provided any motivation whatsoever for modifying the teachings of TIPS to obtain the claimed invention. Absent a showing of the motivation to modify, the Examiner cannot make out a *prima facie* case of obviousness. Consequently, claims 1-26 should be allowed over the prior art.

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For the foregoing reasons, the Applicant submits that the claims of the present application are not fairly taught by and are not obvious in light of, any of the references of record taken either alone or in combination. Therefore, allowance of the present application is in order, and is requested.

Respectfully submitted,

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NOTES/COMMENTS:

ATTN: Examiner JUNG
 Application No. 09/888,452
 Applicant: Gopalan
 Group Art Unit: 2134
 Re: Office Action Mailed 7/28/04
 Request to Reinstate Appeal
 Supplemental Appeal Brief

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APPEAL BRIEF

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Dear Sir:

Please find enclosed the following documents:

1. Request to Reinstate Appeal; and
2. Supplemental Appeal Brief.

Respectfully submitted,

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REQUEST TO REINSTATE APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant filed a Notice of Appeal dated 4/29/2004 and an Appeal Brief on May 11, 2004. The Examiner mailed an Office Action reopening prosecution on 7/28/04. The Office Action cited a single new reference, and rejected claims 1-26 based upon this single reference, and also for the grounds for which appeal was made on 4/29/04.

Applicant respectfully requests that the Appeal be Reinstated. In accordance with this request, applicant has submitted a Supplemental Brief addressed the new reference cited by the examiner.

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